

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant: Fitzpatrick et al. )  
For: Determining Availability of )  
Members of a Contact List in a )  
Communication Device )  
Serial No.: 10/749,083 )  
Filed: December 30, 2003 )  
Examiner: Aminzay, S. )  
Art Unit: 2618 )

**Pre-Appeal Brief Request for Review**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

Applicants hereby request review of the final rejection in the above-identified application. No amendments are being filed with this request. The present request is being filed in conjunction with a notice of appeal. The review is being requested for the reasons stated below, which frames the issue to be considered as part of the pre-appeal review process.

The Examiner continues to reject claims 1-21, under 35 U.S.C. §103(a), as being unpatentable over Crockett et al., US Patent No. 6,873,854, in view of Florkey et al., US Patent No. 6,990,353. However contrary to the Examiner's assertions, the combination of references fail to make known or obvious each and every feature of the claims. Furthermore, the Examiner has failed to articulate a proper motivation to combine, where the individual references are each directed to disparate solutions to different types of problems, and while the Examiner has alleged a combination, the alleged combination has not been shown to be suitably incorporated into the base reference in a manner which is contextually consistent. Consequently, the applicants would contend that the claims have not properly been shown to be obvious in view of the noted

references, and as a result would respectfully request that the rejection be reconsidered and the same be withdrawn.

More specifically, in rejecting the claims, the Examiner appears to allege the presence in the references of individual features in a piece meal fashion, without regard as to any contextual consistency that could be said to suggest that the claimed combination of features would be known or obvious. For example, the primary reference is silent as to any contact list, and alternatively refers to a member list, which is described in the reference as being a list of members to be invited to participate in a call (see col. 2, lines 13-15). However, this is not the same as an availability status of members of a contact list in the context of the present application in so far as the member list as taught by the reference does not concern itself with a status of availability. In other words, a list of people to be invited to a call does not convey any status concerning the members to be invited, but alternatively conveys an indication of the desire for someone else (i.e. the person doing the inviting) to have the particular members participate in the call. In essence, the availability status of member in a member list is irrelevant relative to Crockett et al., '854, in so far as the same is not conveyed to the particular user, which is requesting that the members in the member list be added to the group call.

Consequently, to the extent that the secondary reference, Florkey et al., '353, might allow for the communication of status update information, when a change has occurred, the same is irrelevant with respect to the primary reference, in so far as it relates to circumstances that are contextually inconsistent with the operational circumstances of the primary reference. In other words, an availability status with respect to a buddy list is unrelated to a member list for adding members to a group call, relative to Crockett et al., '854, where the member list associated with adding members to a group call is unconcerned with communicating to a particular client device information regarding availability status of the client devices associated with the contact list of the particular device, such as only when a change has occurred as provided in each of at least independent claims 1, 5 and 15 of the present application. Hence, the applicants' concerns regarding the suitability of combining the references for the alleged purpose of making known each and every feature of the claims, and the applicants' allegations that the Examiner is attempting to piece together disparate elements, which are contextually inconsistent where a teaching to combine should at least relate to a contextually consistent environment.

With regards to claims 5 and 15, the combination of references could hardly be said to relate where the changes are received based upon a periodic determination of whether changes in availability of the other devices have occurred; or with regards to claim 2, where the changes are stored in a queue and transmitted periodically to the particular client device.

Interestingly, with regard to claim 2, instead of finding relative teachings with respect to a queue in a context which is consistent with the claims, the Examiner alternatively provides citations to instances where the cited references discusses a query being made. A query having been made does not generally make known the storage of elements in a queue. Consequently, the Examiner's rejection of claim 2 is similarly problematic, and helps to further highlight the general nature of the Examiner's rejection with respect to claim 2 and the other claims, where the Examiner appears to disregard the context, and merely looks for the presence of similarly named elements without regard to whether one skilled in the art would be motivated to combine them in a way which would make obvious the corresponding claim(s).

In view of the above remarks, the applicants would respectfully request that the Examiner's final rejection of the claims be withdrawn, as failing to set forth a prima facie basis upon which the claims can be properly rejected.

Respectfully submitted,

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